IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Appln. No.:   10/709,360   § Examiner: Irene S. Kang
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Filing Date: April 29, 2004   § Attorney Docket No.: 160245-87US
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Title: METHOD AND APPARATUS FOR DETERMINING PERSONAL QUALIFIED
        DIVIDEND INCOME AND GENERATING INFORMATION STATEMENTS
        THEREOF

APPELLANTS' REPLY BRIEF (37 C.F.R. § 41.41)

This Reply Brief is being submitted in response to the Examiner's Answer mailed April 28, 2009 and is being timely filed within the two month period of time set for response.

If any fees are associated with this Reply Brief are due, please charge such fees and credit any overcharge to Deposit Account No. 50-1017.

Appellants have reviewed the Examiner's Answer and provide the following information to assist the Board of Appeals:

1. The "Grounds of Rejection' in section (8) of the Examiner's Answer is substantively identical to the "Grounds of Rejection" in the Final Rejection mailed August 21, 2008.

2. The "Response to Argument" in section (9) of the Examiner's Answer (pages 18-20) includes new points of argument. Appellants' arguments below address only such new points of argument.

i. In the paragraph spanning pages 18-19 of the Examiner's Answer, the Examiner attempts to rebut Appellants' argument that there is no proper motivation to modify Morano's process in view of PWC to include the claimed personal QDI calculation features by citing well-established case law (*In re McLaughlin*) and arguing that Morano and PWC pertain to analogous art and that the result of combining the art would be predictable.

In response, Appellants will simply agree to disagree that the hindsight reconstruction is improper for all of the reasons presented in the Examiner's Answer. However, even if these

references can be properly combined, the modified version of Morano must still be capable of performing personal QDI calculations since the claims recite a "QDI calculation engine...to automatically determine the personal QDI" (claims 1, 25); or to "automatically [determine] the personal QDI...using a QDI calculation engine" (claims 9, 17, 32, 39); or to "automatically [perform] a personal QDI calculation" (claims 22 and 43). The modified version of Morano would clearly not be able to meet any of these features because PWC fails to disclose how to implement such a feature, and actually states that such implementation "may prove challenging" to both taxpayers and mutual fund companies (page 7, paragraph 1 of PWC). Stated simply, a reference such as PWC that fails to describe how personal QDI calculations are to be performed in the context of mutual fund investing, and which even admits that doing so "may prove challenging," cannot form the basis for modifying Morano to include the claimed personal QDI calculation features.

To be clear, Appellants are not asserting an "Inoperability of References" argument as discussed in MPEP 716.07 with respect to PWC. First, PWC is not a U.S. patent reference, so there is no presumption that PWC provides any sort of enabling disclosure of anything, such as how to perform QDI calculations. Second, Appellants are arguing that PWC fails to provide any explanation whatsoever of any systems, methods or databases that are required to perform personal QDI calculations, and even states that doing so "may prove challenging." That is, PWC never even describes how such a feature would be "operable." In contrast to PWC, the present specification provides 20 sheets of schematic block diagrams, flowcharts, spreadsheets and user interface display screens, accompanied by 27 pages of explanation of how to implement such a feature.

ii. In the first full paragraph on page 19 of the Examiner's Answer, the Examiner attempts to rebut what is perceived to be an argument by Appellants that PWC teaches away from Morano by arguing that the proposed modification of Morano does not change the operation or intent of the primary reference. In response, no such argument was made by Appellants. Appellants made two arguments in the paragraphs spanning pages 13-14 of the Appeal Brief, namely that PWC provides no disclosure of the claimed personal QDI calculation features, and that the proposed modifications to Moreno fail the "obvious to try" test sanctioned

by KSR[1]." Stated another way, Appellants' argument is not that PWC teaches away from adding personal QDI calculations to Morano, but that there is no motivation to do so, and that PWC has no teaching whatsoever of how to add personal QDI calculations to Morano.

iii. In the second full paragraph on page 19 of the Examiner's Answer, the Examiner cites well-established case law that references cannot be attacked individually when the references are used in combination, and asserts that Appellants' arguments are based on such an individual attack of the applied references. Again, the Examiner has mischaracterized Appellants' argument. Appellants' argument is simply that the combination of references, even if proper, lacks at least one claimed feature. Such an argument is not an attack on individual references used in combination. This argument was summarized on page 17, second paragraph, of the Examiner's Answer, repeated below for convenience.

> Second, the Examiner alleges that Appellants attacked the references individually when the rejection was based on the combination of the references. This is well-established case law, but also fails to rebut either of Appellants' arguments for patentability. If feature X is absent from reference A and the rejection relies on modifying reference A to incorporate feature X from reference B, it is entirely appropriate to rebut such an argument by pointing out that reference B does not actually disclose feature X (as discussed above, PWC does not actually have any technical disclosure of the claimed feature), as well as arguing that there is no suggestion or other reason to incorporate feature X into reference A.

The case pertaining to the combinability of references still requires that all claimed features be disclosed or suggested by the combined references. The Examiner's rejection fails this fundamental test with respect to at least claims 1, 9, 17, 22, 25, 32, 39 and 43.

iv. In the third full paragraph on page 19 and the paragraph spanning pages 19-20 of the Examiner's Answer, the Examiner attempts to rebut Appellants' argument that there is no rationale in the applied references to generate personal QDI statements for only those investors who need one. Specifically, the Examiner now provides a three-part rationale for adding this

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[1] *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727 (2007)

feature to the applied references. Following the Examiners' new rationale would only result in a modified version of Moreno that would generate personal QDI statements for all investors, even if the personal QDI is the same amount as the QDI on the Form 1099-DIV. The invention concept of generating personal QDI statements for only those investors who need one is lacking in both of the applied references, and the Examiner's new three-part rationale fails to provide this invention concept.

    v. In the first full paragraph on page 20 of the Examiner's Answer, the Examiner again cites well-established case law that stands for the principle that references cannot be attacked individually when the references are used in combination, and asserts that Appellants' arguments are based on such an individual attack of the applied references. Again, the Examiner has mischaracterized Appellants' argument regarding the patentability of claims 22 and 43. Appellants' argument is simply that the combination of references, even if proper, lacks at least one claimed feature, namely, the feature in step (c) of "automatically comparing in the computer the personal QDI and the QDI on the Form 1099-DIV". This argument was summarized on page 16, first paragraph, of the Examiner's Answer, repeated below for convenience.

> As discussed above, even if personal QDI statements were added to Morano in view of PWC, the resultant modified version of Morano would lack this feature. The modified version of Morano would generate personal QDI statements for all investors, even if the personal QDI is the same amount as the QDI on the Form 1099-DIV. That is, the invention concept of generating personal QDI statements for only those investors who need one is lacking in both of the applied references.

The case pertaining to the combinability of references still requires that all claimed features be disclosed or suggested by the combined references. The Examiner's rejection fails this fundamental test with respect to at least claims 22 and 43.

    vi. In the second full paragraph on the bottom of page 20 of the Examiner's Answer, the Examiner merely summarizes the location of Appellants' arguments and the Examiner's rebuttal arguments in previously filed papers. No substantive arguments are presented in this paragraph, and thus no further arguments are provided with respect to this paragraph.

AN ORAL HEARING IS REQUESTED.

A request for Oral Hearing was filed concurrently with this Reply Brief.

Respectfully submitted,

DORI LASKIN et al.

May 19, 2009   By: _Clark Jablon_
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